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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09 442,898 | 11 18 1999 | MICHEL AGUET | P1696R1 | 6537 |

25213 7590 09/03/2003

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EXAMINER

NICKOL, GARY B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1642

DATE MAILED: 09/03/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/442,898

Applicant(s)

AGUET, MICHAEL

Examiner

Gary B. Nickol Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Request for Continued Examination

The request filed on 06-02-03 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/442898 is acceptable and a RCE has been established. An action on the RCE follows.

Claims 1-2, 4-6, and 23 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 4-6, and 23 are rejected under 35 USC 112, first paragraph, as the specification does not contain a written description of the claimed invention. The newly amended claims reciting "outside the uterus" in Claim 1 has no clear support in the specification and the claims as originally filed. Applicants state (Paper No. 21, page 3) that support for the amendment of Claim 1 is at least at page 10, lines 13-17 of the specification. The suggested support is not found persuasive because the specification does not suggest nor discuss administration "outside the uterus". Hence, this is a new matter rejection.

If applicant should disagree with this rejection, applicant should submit evidence pointing to the serial number, page and line where support can be found for the disputed terminology.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-6, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Briskin *et al.* (US Patent No. 6,514,497, **October 2, 1997**) as further evidenced by Pasquale, E.B. (Current Opinions in Cell Biology, Vol. 9, No. 5, pages 608-615, 1997, IDS)

Briskin *et al.* teach a method of inhibiting angiogenesis in a mammal comprising administering to the mammal an amount of an EphB receptor antagonist which is effective for inhibiting angiogenesis in the mammal, wherein the antagonist binds an EphB receptor.

Briskin *et al.* specifically discuss methods of inhibiting LERK-2 mediated angiogenesis (column 2, line 30+, column 12, line 34+, column 13, lines 8+) in humans, including the use of antibody antagonists (column 6, lines 5+, column 14, lines 55+) comprising contacting cells expressing LERK-2 and or a cell expressing a receptor for LERK-2 (column 1, lines 35+; column 6, lines 18+). As evidenced by Pasquale, E.B., (Table 1, page 609), LERK-2 is also known as Ephrin-B1, a ligand for EphB receptors, *including* the EphB4 receptor, albeit at a lower affinity than Ephrin-B2. Hence, antagonists or antibodies targeting cells that express receptors for LERK-2 (Ephrin-B1) would also bind to cells expressing EphB4 receptors. Further, since the prior art broadly discusses the treatment of humans, such treatment broadly

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encompasses both male and female humans, which invariably would include administration outside the uterus.

Claims 1-2, 4-6, 23 are further rejected under 35 U.S.C. 102(a) as being anticipated by Wang *et al.* (US Patent No. 6,579,683; **April 13, 1998**).

Wang *et al.* teaches methods of inhibiting angiogenesis in a mammal wherein the mammal is suffering from a disease or disorder characterized by undesirable or excessive vascularization or vascular permeability (i.e. varicose veins, tumor formations) comprising administering antagonists of an EphB receptor, including EphB4 wherein the antagonist comprises an antibody that binds an EphB4 receptor (column 14, lines 35-58). The terminology Ephrin and Eph refer to ligands and receptors from any of a variety of animals including humans (column 5, lines 30+). Further, since the prior art broadly discusses the treatment of humans, such treatment broadly encompasses both male and female humans, which invariably would include administration outside the uterus.

No claim is allowed.

The following prior art is provided and made of record (although not relied upon) is considered pertinent to applicant's disclosure: **Daniel *et al.* (US Patent No. 6,555,321)**

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 703-305-7143. The examiner can normally be reached on M-F, 8:30-5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Gary B. Nickol, Ph.D.
Examiner
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GBN
August 27, 2003

